

## REMARKS

This is intended as a full and complete response to the Office Action dated January 28, 2003, having a shortened statutory period for response set to expire on April 28, 2003. Claims 1-30 are pending in the application. Applicant has amended claims 1-13, 15-24, and 29 and the original specification to correct matters of form. Applicant has added new claims 31-36. Claims 14 and 30 have been canceled without prejudice. No new matter has been added. Please reconsider the claims pending in the application for reasons discussed below.

The drawings are objected to under 37 C.F.R. § 1.83(a). The Examiner states that the geometry of claim 4 and the crescent-shaped encapsulation of claim 18 are not shown in the drawings. Applicant respectfully traverses this objection. Figure 3 shows a first arcuate wall 12 possessing a first and second end 16' in addition to a second wall 14 possessing a first and second end 16' wherein the first and second ends of the respective walls connect at 16'. An encapsulation defined by the first and second walls is crescent-shaped, as shown in Figure 3. Accordingly, Applicant respectfully requests removal of the objection to the drawings.

Claims 5 and 6 stand rejected under 35 U.S.C. § 112 as being indefinite. Applicant has amended claims 5 and 6 to correct matters of form. No new matter has been added. Applicant therefore respectfully requests withdrawal of the rejection to claims 5 and 6.

Claim 25 is rejected under 35 U.S.C. § 112 as being indefinite. The Examiner states that a range of general shapes must be delineated to define the phrase "generally shaped" in claim 25. Claim 26 is rejected under 35 U.S.C. § 112 as being indefinite. The Examiner states that a range of compliance to define the phrase "generally complies" in claim 26 must be delineated.

Applicant respectfully traverses this rejection. Applicant submits that specifying a range to delineate "generally shaped" or "generally complies" is not necessary. According to M.P.E.P. § 2173.05(b), when a term of degree is presented in a claim, the standard is whether one of ordinary skill in the art, in light of the specification and in view of the prior art and the status of the art, would be nevertheless reasonably

apprised of the scope of the invention by the term of degree in the claim. Applicant has shown at least one embodiment in Figure 2, and a person of ordinary skill in the art could determine from this embodiment other shapes and other manners of complying. Therefore, the scope of the claim is clear to a person possessing the ordinary level of skill in the art in light of the specification. Accordingly, Applicant respectfully requests removal of the rejection to claims 25 and 26.

Claims 1-3, 7, 19, 22-23, 27, and 29-30 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Castano-Mears et al.* (U.S. Patent Number 6,457,518 B1). The Examiner states that *Castano-Mears et al.* discloses an expandable well screen that expands to substantially contact the wall of the wellbore. The Examiner further states that the expandable well screen contains tubular ribs which convey instrumentation lines. Claims 4-6 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Castano-Mears et al.* in view of Applicant's specification.

Applicant respectfully traverses the above rejections. As shown in Figure 17, *Castano-Mears et al.* teaches hollow ribs which may have lines therethrough which are disposed between the filter media and a shroud. However, *Castano-Mears et al.* does not teach, show, or suggest a recess or control lines disposed within the outer wall of the expandable tool. Because claims 1-7, 9, 19, 22-23, 27, and 29 recite a recess formed in the outer wall of the expandable tubular, Applicant respectfully requests removal of the rejection to independent claim 1 and its dependent claims 2-7, 9, and 19, independent claim 22 and its dependent claims 23 and 27, and independent claim 29.

Claims 8, 10-13, 15-18, 20-21, 24-26, and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Castano-Mears et al.* in view of *Ramos et al.* (U.S. Patent Number 6,446,723 B1). The Examiner states that *Castano-Mears et al.* discloses an expandable well screen, as discussed above, but fails to disclose a crescent-shaped encapsulation within the recess for conveying lines. The Examiner states that *Ramos et al.* discloses a crescent-shaped encapsulation. The Examiner then states that because *Castano-Mears et al.* discloses that the ribs may collapse under excessive expansion force, it would have been obvious to a person of ordinary skill in the art to insert the crescent-shaped encapsulation of *Ramos et al.* within the ribs of *Castano-Mears et al.* to prevent collapse.

Applicant respectfully traverses this rejection. The arguments stated above regarding *Castano-Mears et al.* apply equally to the rejection of claims 8, 10-13, 15-18, 20-21, 24-26, and 28. Furthermore, *Ramos et al.* does not teach, show, or suggest an encapsulation within an outer wall of an expandable tubular. The resilient sheath surrounding the cable of *Ramos et al.* is not taught in the context of expandable tools. It would not have been obvious to one of ordinary skill in the art to combine *Castano-Mears et al.* with *Ramos et al.* because *Ramos et al.* teaches away from using the resilient sheath with expandable tools. Specifically, *Ramos et al.* states that the distance from an outside wall of the borehole to the cable is maximized to reduce the likelihood of mud not being displaced from the region between the cable and the outer wall of the borehole when cementing occurs. See col. 2, lines 43-48. Because using the sheath in the context of expandable tools would minimize the distance from the cable to the wellbore and because an objective of *Ramos et al.* is to maximize the distance, *Ramos et al.* teaches away from combining its resilient sheath with the ribs in the expandable tools of *Castano-Mears et al.* Therefore, *Castano-Mears et al.*, alone or in combination with *Ramos et al.*, does not teach, show, or suggest an expandable tubular comprising an outer wall having a recess formed therein for housing one or more of the following, as recited in claims 8, 10-13, 15-18, and 20-21. Furthermore, *Castano-Mears et al.*, alone or in combination with *Ramos et al.*, does not teach, show, or suggest one or more of the following located within an outer wall of an expandable tubular, wherein the one or more of the following is protected during the expansion process, as recited in claims 24-26 and 28. Accordingly, Applicant respectfully requests removal of the rejection to claims 8, 10-13, 15-18, 20-21, 24-26, and 28.

Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and intervening claims. Applicant has canceled claim 14 and rewritten it as claim 31, with changes as to matters of form, in independent form including all of the limitations of the base and intervening claims. The original elements of claim 14 have been preserved in new claim 30. No new matter has been added. New claim 32 depends from allowable claim 31. Therefore, Applicant respectfully requests allowance of claim 31 and its dependent claim 32.

Claims 10-13, 15-16, 18, 20, and 28 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent Application No. 09/964160. Applicant has enclosed herewith a Terminal Disclaimer regarding the patent application cited by the Examiner. Accordingly, withdrawal of the rejection and allowance of the claims is respectfully requested.

New claims 33-36 depend from claim 1 and are allowable for the same reasons that claim 1 is allowable, as described above. Therefore, Applicant respectfully requests allowance of claims 33-36.

In conclusion, the references cited by the Examiner, neither alone nor in combination, teach, show, or suggest the method or apparatus of the present invention. Having addressed all issues set out in the office action, Applicant respectfully submits that the claims are in condition for allowance and respectfully requests allowance of the claims.

The prior art made of record is noted. However, it is believed that the secondary references are no more pertinent to the Applicant's disclosure than the primary references cited in the office action. Therefore, it is believed that a detailed discussion of the secondary references is not deemed necessary for a full and complete response to this office action. Accordingly, allowance of the claims is respectfully requested.

Respectfully submitted,

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